

**Notice of Allowability**

Application No.

10/541,387

Applicant(s)

GYNTHER ET AL.

Examiner

Yong Chu

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/05/2007.
2. ☒ The allowed claim(s) is/are 5-8 (renumbered as 1-4).
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All   b) ☐ Some\*   c) ☐ None   of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),  
Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

## **DETAILED ACTION**

Claims 1-4 and 9-15 have been canceled by the Amendment filed on 11/05/2007.

Therefore, Claims 5-8 are pending.

### ***Response to Amendment***

The Amendment by Applicants' representative Jill K. MacAlpine dated 11/05/2007 has been entered.

### ***Response to Arguments***

#### **Objection to Abstract**

The objection to claim 1 for informality is moot, because claim 1 has been canceled.

The objection to claim 5 as being substantially duplicate of claim 1 has been withdrawn, because claim 1 has been canceled.

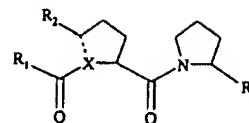
#### **Claim rejection under 35 U.S.C. §112, 2<sup>nd</sup> paragraph**

The rejection of claims 1 and 5-8 is moot, because claim 1 has been cancelled. The rejection of claims 5-8 has been withdrawn.

#### **Claim rejection under 35 U.S.C. §102(e)**

Applicant argued that the chemical structure of the '695 patent is patentably distinct from the instant invention because **X** is O for instant application, and **X** is C<sub>1</sub>-C<sub>7</sub> alkyl group for the '695 patent. This argument has been fully considered, and is found persuasive. Therefore, the claim rejection under 35 U.S.C. §102(e) has been withdrawn.

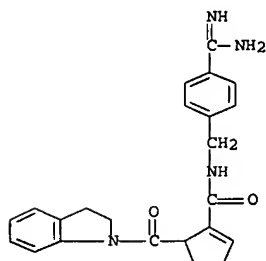
### Reasons for Allowance



The present invention is directed to a compound of formula (I) wherein, wherein  $X$  is C; the dotted line represents a double bond;  $R_2$  is H, and  $R_1$  and  $R_3$  are defined in claim 1, or a pharmaceutical composition comprising a compound according to claim 5.

The closest prior art of record is by Thorstensson et al., *Journal of Medicinal Chemistry*, **2003**, 46(7), pp.1165-1179.

Thorstensson et al. discloses a compound (CAS RN 516491-20-6) of formula



However, this compound is patentably distinct from the instantly claimed compound, because the pyrrolidine ring of the instantly claimed compound is a non-fused pyrrolidine ring, while the Thorstensson compound has the pyrrolidine ring fused with a benzene ring forming an indoline ring.

### Conclusions

- Claims 5-8 are allowed.

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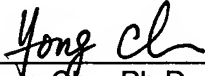
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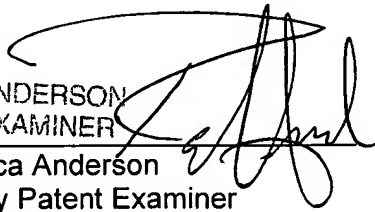
### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
\_\_\_\_\_  
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